

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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REPLY BRIEF FOR THE APPELLANT

Ex parte HASEBE et al

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Technology Center 2100

STORAGE MEDIUM FOR PREVENTING AN IRREGULAR USE BY A THIRD PARTY

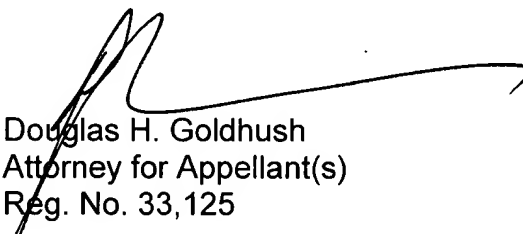
Serial No. 09/476,319

Appeal No.:

Group Art Unit: 2132

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January 28, 2004

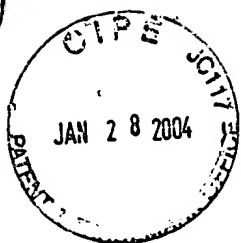

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Atty. Docket: 58622.09028

DHG/scc

Encl: Reply Brief (in triplicate)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In re the Appellant:

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Appeal No.:

Serial Number: 09/476,319

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Filed: December 30, 1999

Examiner: Gilberto Barron, Jr.

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For: STORAGE MEDIUM FOR PREVENTING AN IRREGULAR USE BY A THIRD
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REPLY BRIEF

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I. INTRODUCTION

This Reply Brief is filed in response to the Examiner's Answer dated December 4, 2003. In that Examiner's Answer, while no new grounds of rejection are made, comments and explanations are provided which are tantamount to new points of argument. This Reply Brief, therefore, is submitted to address these new points of arguments, and to clarify why claims 1-56 and 111-125 of the pending application should be considered to be statutory subject matter under 35 USC § 101, and therefore should be found by this Honorable Board of Patent Appeals and Interferences to be allowable.

Claims 1-56 and 111-125 were finally rejected under 35 USC § 101 as being directed to non-statutory subject matter. The rejections, and the claims, are appropriately characterized in the applicants' Appeal Brief which was filed on September 30, 2003.

II. REPLY TO ARGUMENT

On page 5 of the Examiner's Answer, it is explained that, in the Examiner's

opinion:

"None of the 40 independent claims recites an invention that, as a whole, is a description of material that is functional in the sense that it may impose a particular organization on a computer system or provide a framework under which the operation of a computer may be improved. The data structure described in the claims is a data structure without a functionality that could be imparted to a computer so as to affect a particular organizing structure, operation or a process of a computer, or in any way result in an improved computer."

On page 7 of the Examiner's Answer, it is stated that:

"The Examiner also agrees with applicant that an article of manufacture of may be statutory. However, when the article of manufacture is merely the carrier for non-functional descriptive material, as in a CD with music recorded thereon, the invention would not pass muster under section 101. All of the appealed claims are directed to a storage medium which is comprised of different types of data or has different areas for storing different types of data. However, none of the data types and none of the data structures resulting therefrom, are functional in nature. Nor can they be shown to impart functionality to a computer when a computer accesses the claimed storage medium simply because that functionality is already charged to the computer."

Applicants strongly but respectfully submit that these characterizations of the present invention are inaccurate, and that the present invention, as recited in the presently pending claims, contains subject matter which is in compliance with 35 USC § 101, and more particularly is in compliance with the requirements for computer-related inventions as set forth in MPEP § 2106.

As explained on pages 2 and 3 of the applicants' Appeal Brief, the claims are directed to various embodiments of a storage medium which is accessed by a vendor computer and a user computer, or a first computer and a second computer, wherein encrypted electronic data is decrypted by the user computer.

This type of data structure alone cannot be considered to be comparable to a compact disc or a music CD, wherein data is directly "played" by the computer. Additionally, embodiments of the invention include a medium personal number provided on the storage medium, with the medium personal number being particularly personal or specific to that particular storage medium. When the storage medium is interacting with the computer, the medium personal number is used for generating a decryption key for decrypting the encrypted electronic data in the user computer. After the medium personal number is read by the user computer, the user computer can then access permission information (claim 1) which is provided on the storage medium which includes the decryption key. The permission information and the medium personal number therefore enable the user computer to decrypt the encrypted decryption key and to decrypt the encrypted electronic data in a manner that the user computer does not use the specific apparatus number for the specific computer in decrypting the encrypted decryption key and the encrypted electronic data. This significant interrelationship between not only the elements of the article of manufacture but between the article of manufacture and the computer clearly place the claims in compliance with 35 USC § 101. MPEP § 2106 clearly explains that a claim which is limited to a machine or manufacture which has a practical application in the technological arts is statutory (MPEP § 2106(IV)(B)(II)(a)). MPEP § 2106(IV)(B)(1) also explains that a "computer that recognizes a particular grouping of musical notes read from memory, and upon recognizing that particular sequence, causes another defined series of notes to be played, defines a functional interrelationship among the data

and the computing processes performed when utilizing that data, and as such is statutory because it implements a statutory process." The present invention is directed to a storage medium which is configured to interact with a computer that recognizes a particular set of data on the storage medium, and upon recognizing that data, causes another define series of events to occur (in particular, the generation of a decryption key, and the decryption of encrypted data stored on the disk). It is respectfully submitted, therefore, that the presently claimed invention as recited in claims 1-56 and 111-125 defines a functional interrelationship among the storage medium and the computer when utilizing data on the storage medium, and therefore that the claims are directed to statutory subject matter because a statutory process is being implemented.

Page 3, lines 19-20 of the Examiner's Answer state:

"The claims seek to patent a storage medium that is a repository for specific type data, but that data is not functional in nature. The data on the storage medium is solely to be acted on by another process when imparted to a computer."

This statement seems to support applicants' arguments that the presently pending claims are directed to statutory subject matter as discussed above; MPEP § 2106(IV)(B)(1) explains that a functional interrelationship among data and computing processes performed when utilizing that data is statutory because it implements a statutory process. It is further submitted that the statement noted above on page 3 of the Examiner's Answer seems to be inconsistent with the following statement on page 4 of the Examiner's Answer, which states:

"In analyzing the claimed invention, none of the 40 independent claims (and

their 31 dependent claims) recites a step, a series of steps, a process, method, program, instructions, or any other functional descriptive material that would cause or instruct a computer to perform step(s) that are part of a particular process or method to result in a practical application. The data structure of the instant claims is not functional, in this sense, because it does not set forth any active step(s) of any process or any method."

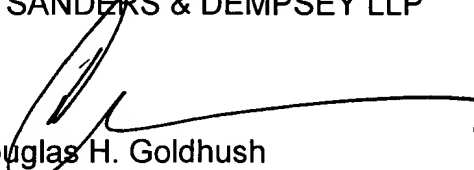
It would seem, therefore, that page 3 of the Examiner's Answer attempts to argue that the data on the storage medium is acted on by another process when imparted to a computer, while the statement on page 4 of the Examiner's Answer seems to argue that the data on the storage medium according to the present invention does not involve any process or method. In any event, however, as discussed above, applicants strongly but respectfully submit that the claimed invention should be found to be directed to statutory subject matter because it implements a statutory process as required by 35 USC § 101, and MPEP § 2106.

In view of the above, therefore, it is respectfully requested that this Honorable Board of Patent Appeals overturn the outstanding rejections of claims 1-56 and 111-125, and find these claims to be in condition for allowance.

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Respectfully submitted,

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